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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,240	12/18/2001	Hiroshi Tanaka	0879-0366P	8756
2292	7590	04/07/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			KAROVALIA, SAMIR	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/020,240	TANAKA ET AL.	
	Examiner	Art Unit	
	Samir S. Karovalia	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 14-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-13 and 20-25 is/are allowed.
- 6) ☒ Claim(s) 1-9 and 14-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1 This office action is in response to reopened prosecution following applicant's pre-appeal brief conference filed on 11/21/2005.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,968,365 B2 to **Hollstrom** et al (hereinafter, "**Hollstrom**"), of record.

In regard to claim 1, **Hollstrom** discloses a digital camera (i.e. communication terminal) which is capable of connecting to a web server (i.e. communication apparatus) on the Internet (i.e. network) through a mobile telephone (i.e. cellular phone). As noted on FIG.1 and col. 5, line 58 – col. 6, line 28, the digital camera connects to the cellular phone, where the cellular phone can control the different functions of the digital camera through an infrared connection, a serial cable, or a Bluetooth (i.e. short range) interface. Additionally, the stored pictures on the digital camera are then published (transmitted) to a web server on the Internet. Furthermore, the digital camera with the WAP server module is inherently capable of accessing information on the Internet and is able to

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retrieve (receive) pictures from the Internet (network). See col. 6, lines 35-38, where few of the functionalities of the camera are listed.

In regard to claim 2, establishing a Bluetooth connection between two devices (i.e. digital camera and cellular phone) requires the displaying of communication information (i.e. whether the devices had established connection or not).

In regard to claim 3, a batch file [i.e. captured picture file (e.g. widely used picture file formats JPEG, GIF, TIF, PSD...etc)] is clearly disclosed by **Hollstrom**, which is recorded prior to being sent to a web server on the Internet. See col. 1, lines 59-61.

In regard to claim 4, see col. 6, lines 14-28.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9 and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,943,603 to **Parulski et al.** ("**Parulski**") in view of U.S. Pat. No. 6,968,365 B2 to **Hollstrom et al.** (hereinafter, "**Hollstrom**"), of record.

In regard to claim 1, **Parulski** discloses a communications terminal (combined cellular telephone/digital camera) (Fig. 7-9). The communications terminal comprises a receiving device (control processing unit 62) for receiving connection information (in the form of standard fax connection modes such as group VI fax) from a communication apparatus (destination fax machine) in order to properly transmit the stored image to the destination fax (col. 4, lines 50-67). Note that Group IV fax specifies a machine which operates at 64 Kps, which can only work on a digital channel, and which takes six seconds to transmit a 8 ½ x 11 page, and which supports certain progress codes. Thus, the Group IV connection mode strongly relates to connection information (e.g., digital, transmission speed, etc.). The connection information is received from (via) the cellular telephone (Fig. 7) part of the communication terminal. Thus, the connection information is for making a communication connection to the communication apparatus from a cellular phone. **Parulski** also discloses that the communication terminal comprises a transmitting and receiving device (cellular transceiver 66), which transmits and receives information to and from the communication apparatus (destination fax machine) based on the connection information received from (via) the cellular telephone receiver. For example, the transmitting and receiving device (transceiver 66) will have to support 64 Kps digital channel and certain fax progress codes (connection information). Thus, the information transmitted and received is based on the connection information.

Parulski discloses a combined cellular telephone/digital camera communicating to plurality of receiver units (Fig. 1, A-C) via RF transmitter (col. 4, lines 10-15) and thus

fails to disclose that the communication terminal (digital camera) is separate from the cellular phone and locally positioned relative to the cellular phone when receiving the connection information.

However, **Hollstrom** teaches a digital camera separate from a portable telecommunication apparatus (cellular phone) and locally positioned relative to the telecommunication apparatus to connect to a global information network such as the Internet for distributing information such as pictures captured by the digital camera (col. 1, lines 59-61 and col. 2, lines 24-30). Additionally, refer to Fig. 1, where the digital camera 50 is placed relative to the cellular phone 1. The interconnection between the digital camera and the cellular phone can be in the form of a wireless short-range RF Bluetooth connection (see col. 7, lines 17-23) which has a relative range of 10m.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to separate the integrated device (e.g., digital camera/cellular telephone) of **Parulski** into distributed devices as taught by **Hollstrom** and yet be an integral unit (e.g., digital camera connecting to the cellular telephone via Bluetooth as a single unit) to access the Internet for distributing the pictures captured by the digital camera.

The suggestion/motivation for doing so would have been to break an integrated device (e.g., the communication terminal (digital camera)/cellular device) into distributed devices in order to increase the flexibility of the device (e.g., the digital camera can be freed from the cellular telephone) and to reduce the cost to repair (e.g., the separate devices can be repaired/replaced individually).

In regard to claim 7, claim 7 does not differ substantively from claim 1 with the exception that claim 7 recites the receiving device receives a "menu of destinations", which reads on camera display screen, which supports a menu of icons for the user to select, where the icons refer to destinations (Fig. 6 and col. 3, line 64 – col. 4, line 9). Claim 7 also recites an "input device", which reads on pen or stylus used to select the displayed icons.

In regard to claim 2, see Fig. 6, where the connection information as it relates to transmission data comprises which connected receiving device (destination fax machine) the picture will be transmitted to.

In regard to claim 3 and 8, **Parulski** discloses in abstract, lines 19 and 20, the communication terminal records a batch file [i.e. storing electronic image data (e.g. widely used picture file formats JPEG, GIF, TIF, PSD...etc) generated by the camera module] in advance for transmitting the batch file to the communication apparatus. For further details refer to the rejections of claim 1 and 7.

In regard to claims 4 and 9, the connection information includes attribute information such as a particular fax mode. Also, the connection information includes a particular dialed phone number (Fig. 10).

In regard to claim 5, the use designates (selects) a destination fax machine (communication apparatus) via an inputting device such as a "pen" (Fig. 6) or a keyboard (col. 5, lines 10-16) for the reception of picture data. The designation (selection) process includes discovering the capabilities of the designated communication apparatus (fax machine) based on connection information received from the fax machine via the cellular phone before any actual picture data is transmitted (col. 4, lines 44-67) (see also the claim 1 rejection). The camera (transmitting device) would then transmit and receive information to and from the designated communication apparatus (fax machine) based on the connection information previously received from the fax machine (via the cellular telephone) during the designation process. For example, Group IV fax includes progress codes (connection information) that are sent from the fax machine back to the transmitting device.

In regard to claims 6, 15 and 18, see Fig. 6. See the claim 2 rejection for further details.

In regard to claims 14 and 17, the communication terminal (camera) is at least partially digital.

In regard to claims 16 and 19, the mode switching element reads on the user selecting a destination fax machine, which switches the device into a communication mode all as discussed above. In addition, see col. 4, lines 44-50, where the "#" key is

part of the separate communication termination/cellular phone combination as modified in the claim 1 rejection.

Allowable Subject Matter

6. Claims 10-13 and 20-25 are allowed.

Examiner's Reasons for Allowance

7. Independent claims 10 and 12 are detailed claims that recite significant structural detail sufficient to patentably distinguish over the prior art of record. For example, the subject claims recite the both the cellular phone and the communication terminal comprises a separate "receiving device" and a "transmitting and receiving device." Further, the cellular phone comprises an additional separate receiving device. Thus, a prior art arrangement where the cellular telephone comprised two "transmitting and receiving devices" (e.g., for each RF link) as is commonplace in the art would distinguish over the express language of the subject claims. Further regarding claim 10, the "transmitting and receiving device" in the cellular phone sends and receives information to a separate communication apparatus. However, the "transmitting and receiving device" in the communication terminal also sends and receives information to the communication apparatus. Thus, a prior art arrangement where only one link was used to send connection information to the communication apparatus would distinguish over the express language of the subject claim 10. Further regarding claim 12, the transmitting and receiving device in the cellular phone is limited to a "dial-up

connection" to the communication apparatus. Thus, a prior art arrangement that efficiently used a non-dialup connection (e.g., non-voice data signaling) would distinguish over the express language of the subject claim 12.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Petite (U.S. Patent No. 6,618,578 B1) discloses a system and method for communicating between a personal data access device (e.g. laptop, digital camera,...) and a remote communication unit via RF link [i.e. wireless communication nodes (e.g. mobile phones)].


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samir S. Karovalia whose telephone number is 571-272-8133. The examiner can normally be reached on Monday-Friday, 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Applicant is notified that the Art Unit location of your application in the USPTO has changed to 2617.

SSK/ssk
Art Unit: 2617


DUC NGUYEN
PRIMARY EXAMINER